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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  9623-381 (Y00437US00)								
<u>Certificate of EFS Filing Under 37 CFR §1.8</u> I hereby certify that this correspondence is being electronically transmitted to the USPTO, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8. on <u>January 14, 2010</u>  Signature <u>/Nathan O. Greene/</u>  Typed or printed name <u>Nathan O. Greene</u>	<table border="1" style="width: 100%; border-collapse: collapse;"><tr><td style="width: 50%; padding: 5px;">Application Number  09/993,926</td><td style="width: 50%; padding: 5px;">Filed  11/13/2001</td></tr><tr><td colspan="2" style="padding: 5px;">First Named Inventor  Dominic Dough-Ming Cheung</td></tr><tr><td style="padding: 5px;">Art Unit  3691</td><td style="padding: 5px;">Examiner  Muriel S. Tinkler</td></tr></table>		Application Number  09/993,926	Filed  11/13/2001	First Named Inventor  Dominic Dough-Ming Cheung		Art Unit  3691	Examiner  Muriel S. Tinkler		
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First Named Inventor  Dominic Dough-Ming Cheung										
Art Unit  3691	Examiner  Muriel S. Tinkler									
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%;"><tr><td style="width: 50%; vertical-align: top;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; vertical-align: top;"><u>/Nathan O. Greene/</u> Signature</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="vertical-align: top;"><u>Nathan O. Greene</u> Typed or printed name</td></tr><tr><td style="vertical-align: top;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>56,956</u></td><td style="vertical-align: top;"><u>801-355-7900</u> Telephone number</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="vertical-align: top;"><u>January 14, 2010</u> Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			<input type="checkbox"/> applicant/inventor.	<u>/Nathan O. Greene/</u> Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<u>Nathan O. Greene</u> Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>56,956</u>	<u>801-355-7900</u> Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>January 14, 2010</u> Date
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<input type="checkbox"/> *Total of _____ forms are submitted.										

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
Dominic Dough-Ming Cheung et al.	)	
	)	Examiner: Muriel S. Tinkler
Application No. 09/993,926	)	
	)	Group Art Unit No. 3691
Filing Date: November 13, 2001	)	
	)	Confirmation No.: 5426
For: POSITION BIDDING IN A PAY FOR	)	
PLACEMENT DATABASE SEARCH	)	
SYSTEM	)	

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandra, VA 22313-1450

Dear Sir:

A second final Office Action ("Second Final Action") for the present application issued on December 23, 2009, rejecting again all pending examined claims 1, 2, 5-23, 37, and 39-50. The Applicants' Counsel has responded to seven Office Actions, and for reasons discussed below, believes this Second Final Action to be inadequate at least in omitting one or more essential elements needed for a prima facie rejection of the claims. Publication and patent numbers of references are omitted; reference thereto is made in the Last Response, dated August 17, 2009.

**35 U.S.C. § 103(a) Rejections**

As in previous Office Actions, the Second Final Action also relies on unsupported implication of claim language within cited references and, of more concern, does not appear to consider all of the claim language in many of the independent claims. In some instances, claim features are completely absent from the cited art or the detailed rejection of some claims such that the Second Final Action fails to make out a prima facie case of obviousness. Without repeating the entirety of the Last Response (or previous responses), the following sets forth some of the deficiencies.

In rejecting claim 37, the Examiner states that "Davis also discloses receiving a search query matching a selected search listing and forwarding the searcher to a search results list with listing position according to rank," pointing to two sentences of the Abstract of Davis. While some features of claim 37 were also addressed in rejection of claim 1, much language of the page-long claim 37 has not been considered, and certainly the combination of features has not been fully addressed. As just one example, the Examiner has not addressed: "receiving, by the server over the network, from an affiliated web service provider a search query matching a selected search listing, the search query entered by a searcher accessing a web site of the affiliated web service provider." Indeed, the Second Final Action, as previous actions, completely fails to mention this language. Claims 44 and 45 also include this language.

Each of the independent claims recites handling of tie a tie condition. For example, claim 1 recites:

if a tie condition makes a desired rank unavailable for a respective search listing, incrementing by the server a bid amount for the respective search listing to break the tie condition such that the respective search listing is ranked higher than the search listing with which the respective search listing previously had the same bid amount.

The Second Final Action, as in previous actions, cites to Davis, claim 19 and to FIG. 8 (display user entered bid changes) and element 830 as showing these features. Davis, FIG. 8, discloses a method by which advertisers change bids. As conceded to in paragraph 8 of the Second Final Action, the process of adjusting bids in Davis is not automated. The only mention of addressing a tie is with respect to equivalent bid amounts as recited in claim 19 of Davis. Claim 19, however, discloses use of creation time values for each search result list having equivalent bid amounts, and sorting the listings in order from earliest to most recent creation time value. This does not, in contrast with claim 1, disclose that a bid amount of one of the search listings be incremented in order "to break the tie condition such that the respective search listing is ranked higher than the search listing with which the respective search listing previously had the same bid amount." If the search listing in Davis had a later creation time value, it would not be ranked higher and Davis does not disclose or suggest how it could be ranked higher, but merely discloses a method that may be used for sorting a search result list having equivalent bid amounts. Without disclosing how a bid amount of the search listing could be adjusted so that the search listing could be ranked

higher in the case of a tie condition, Davis also does not disclose or suggest how to meet the desired rank of the search listing in this scenario.

Konia fails to fill the gap in disclosure of Davis. It does not address tie conditions or the case when bid amounts may be equivalent. Even if the method of claim 19 of Davis were automated according to the system and method of Konia, it would still not disclose or suggest all of the claim features. Accordingly, despite specific amendments to clarify how the claim language distinguishes over the prior art, the Second Final Action does nothing to add to previous actions, citing to the same passage of Davis as in previous actions. This is inadequate and does not, alone or in combination with Konia, disclose or suggest the claim language.

Claim 37 was also amended in the last response to recite "the selected search listings being designated ***premium search listings*** by enabling the advertiser to limit the desired rank to one of a predetermined small number of positions near the top of the search result list" (emphasis added). Claim 45 was amended to recite, in part:

some of the search listings being designated ***premium search listings*** if ranked within a top predetermined small number of the search listings. .

\* \* \*

upon receipt of a new bid amount and desired rank for a search listing designated as ***a premium search listing***, to automatically adjust the respective bid amount of the specified search listing until the rank of the specified search listing in the rank order of search listings is greater than the desired rank or until the respective bid amount of the specified search listing is less than the new bid amount. . .

\* \* \*

the produced search results ***including one or more premium search listings*** for display to the affiliate web site searcher ranked near the top of the produced search results in accordance with the desired rank.

(emphasis added). In the Last Response, the claim language was amended to clarify that the premium search listings were within a predetermined **small** number of positions near the top of the search result list. For instance, the original disclosure refers to an example of premium listings as **the top three search listings** for a search term because of the increased likelihood of being clicked by the user because they "will be seen by a larger number of searchers using the World Wide Web." Page 11, lines 6-11. It is important to note that the above claim language does not just refer to premium search listings in the abstract, but

allows an advertiser to designate at least some of the search listings as premium to limit their desired rank to a range of positions, namely those within a predetermined small number of positions near the top of the search result. This provides an efficient option for optimal placement to an advertiser without being tied to the always-most-expensive, top-most position.

In contrast, the Second Final Action points to Davis, column 5, line 35, through column 6, line 15, referring to "paid search listings" for premium search listings. Page 4, ¶ 11. In the next paragraph (numbered 12), the Second Final Action further explains that Davis discloses a preferred number of 40 premium (paid) search listings. Col. 18, ll. 4-18. Counsel assumes, however, that the Examiner meant to refer to lines 29-31 of column 18, which states there are 40 slots for paid search listings, which will be backfilled with unpaid listings if there are insufficient paid listings.

This disclosure in Davis does not disclose this unique feature of the amended claim language as Davis refers to all paid search listings in a generic way and the claim language specifically refers to a predetermined small number of positions near the top of the search result page. In the context of a search result page, 40 is not a small number. Indeed, Figure 7 of Davis which is referred to in column 18 displays only eight (8) total slots so, presumably, 32 slots would be found on subsequent pages and would not be viewed by nearly as many as the original eight on the first page. There is nothing premium about any listing farther down the page on the first page or a listing on other-than-the-first search results page. Accordingly, Davis does not disclose or suggest the designated premium search listing language of claims 37 or 45. Konia and the other cited art fail to fill the gap.

For all of the above reasons, the independent claims are patentable over the cited art, alone or as combined. The claim language not even addressed, and the claim language completely absent from the cited art, indicates that the claims should be allowed or more pertinent art cited. Prosecution should progress, without further delay, with either an allowance or a newly-issued Office Action with adequate rejections.

### **35 U.S.C. § 101 Rejections**

In response to arguments, the Second Final Action stated that Counsel's arguments in the Last Response were persuasive, and withdrew all § 101 rejections. Page 2. Strangely, however, new § 101 rejections of claims 1-18, 22-23, 37, and 39-43 were inserted at pages 5-6. The Second Final Action states in paragraph 18 that the claims "do

not contain any hardware in the body of the claims that perform calculation or transformation of the data (i.e. purely software claims)." This is incorrect, however, as each independent claim (1 and 37) is tied to at least a server having a processor and memory. While the server is introduced in the preamble, it is incorporated into the body of the claims as a limitation by reciting the server as the actor in each element. "When limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention." *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1305-1306 (Fed. Cir. 2005), (quoting *Eaton Corp. v. Rockwell Int'l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003)). See also *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1350 (Fed. Cir. 1998) ("[A] preamble usually does not limit the scope of the claim unless the preamble provides antecedents for ensuing claim terms and limits the claim accordingly.")

Accordingly, the body of claims 1 and 37 each recite a machine (hardware) to which the methods are tied, complying with *Biliski's* machine-or-transformation test. *In re Bilski*, 545 F.3d 943, 952 (Fed. Cir. 2008). Counsel believes that the § 101 rejection was inadvertently, and incorrectly, reissued by the Examiner and respectfully requests the same be withdrawn.

### **Conclusion**

For at least the above reasons, Applicants respectfully request review of the Second Final Action directed against the current application and withdrawal of the rejections against the claims.

Respectfully submitted,

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January 14, 2010  
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